

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Finality of Office Action

On December 21, 2006, Applicants filed a request to withdraw the finality of the Office Action dated November 21, 2006. That request has not been acted upon. However, Applicants respectfully submit that the finality of that Office Action clearly was improper. Therefore, Applicants again respectfully request that the Examiner reconsider and withdraw the finality of the Office Action dated November 21, 2006.

Showing Required by 37 CFR § 1.116(b)

In the event that the finality of the Office Action dated November 21, 2006, is *not* withdrawn, then Applicants wish to address the showing required by 37 CFR § 1.116(b) as to why the amendments above are necessary and were not presented earlier. This amendment is responsive to new grounds of rejection in the final rejection, for example, point 9 on page 3 thereof, and, therefore, this amendment clearly is necessary. Moreover, since this is the first substantive response to the final rejection, clearly this amendment could not have been presented earlier. In view of the foregoing, Applicants submit that a

proper showing has been made. Therefore, Applicants respectfully request that the Examiner enter and consider these amendments.

Substance of Office Action dated November 21, 2006

Claims 1-4 and 6-17 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants have amended the claims in a manner that Applicants believe overcome the Examiner's points 7-9 on pages 2-3 of the Office Action.

With respect to the Examiner's point 10, Applicants respectfully point out that that the modifying agent of claim 11 has two phosphate ester groups. This is in accord with the express teachings of the specification at page 12, lines 10-14, that compounds having one or more phosphonic acid/ester groups can be used as modifying agents. Where, as in claim 11, a compound with two phosphonic ester groups is used, one of these groups is available for coupling to nanoparticles and the other is available for coupling to a molecule other than said nanoparticles—exactly as required by claim 1.

Finally, with respect to the Examiner's point 11, Applicants respectfully submit that there is no inconsistency between claim 1 and claim 10. The synthesis period in claim 10 is made up of a first portion before the modifying agent is added and a second portion after the modifying agent is added.

Claims 1-3 and 6 were rejected under 35 USC § 102(e) as being anticipated by Haubold et al. ("Haubold"), US 2003/0032192. In response, Applicants again submit that Haubold cannot constitute an anticipation. Haubold's description of an alkane chain

carrying “at least one * * * or a combination of these groups” is not a teaching or a specific combination of any of the groups. Absent a teaching of a specific combination, there is no anticipation.

The Examiner says Haubold discloses a combination comprising a phosphate group and a carboxylic acid group in claims 3 and 6. However, the Examiner has had to make selections in order to arrive at this combination. The act of selection negates Haubold constituting an anticipation given the large number of species embraced by these claims.

There is no specific teaching in Haubold of an alkane chain in a phosphorus-containing molecule having two different functional groups. There also is no specific teaching in Haubold even of alkane chain in a phosphorus-containing molecule having even one functional group.

Respectfully, Haubold does not anticipate the instant claims. An early notice to that effect is earnestly solicited.

Claims 4, 14 and 15 were rejected under 35 USC § 103(a) as being obvious over Haubold. In response, Applicants point out that this rejection was premised on Haubold constituting an anticipation of the basic aspects of the present invention. Since this premise has been shown above to be in error, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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